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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LUGO, CARLOS

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,093

Applicant(s)

LEI, JONATHAN L.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-104 is/are pending in the application.
- 4a) Of the above claim(s) 93-101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-92, 102-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> |

Continuation of Attachment(s) 6). Other: Copy of Initialed Interview Request Form.

DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on December 13, 2004.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:
 - Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. **Claims 84-91 and 102-104 are rejected** under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

The current invention is non-stationary since the executable code fails to disclose that is stored on a computer readable medium in order to be able to operate. See MPEP § 2106.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. **Claims 91 and 92 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 91 and 92 recites that the event is arriving in an area where a wireless networking protocol that utilizes short-range radio waves is operating and that the event is arriving in an area where a device is broadcasting other self-contained business transaction capsules. However, it is unclear how those limitations are

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related to the transaction between the transaction participants, as claimed in claim 84. Therefore, in order to continue with the examination, the claims will be given the broadest interpretation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 84,88,89,102 and 104 are rejected** under 35 U.S.C. 102(a) as being anticipated by Tryllian.

Regarding claims 84 and 102, Tryllian discloses a self-contained transaction capsule to conduct a wireless transaction. The capsule comprises:

- a) Data, regarding transaction products and transaction services (products or services that each participant offers, i.e., when a user wants a DVD at a certain price, the user sends his agent to find other agents that offer a DVD or other products or services related to a DVD presented by other agents, Page 6).
- b) Data regarding the transactions participants (data of the users concentrated in the agents).
- c) Logic, enabling interaction between the transaction participants and the capsule (when the agent is send by the user with a task, i.e., looking for a DVD, the agent collect information from other agents of other users, therefore, there is an interaction between the users and the agent).

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d) Logic, enabling modification of the wireless transaction (when a user wants a DVD, the user sends his agent to find other agents that offer a DVD, however the agent is capable of also find other stuff that the user can be interested, Pages 6 and 7).

e) Logic, regarding the wireless transaction and enabling transfer of the capsule (agent) from a wireless electronic device to other transaction participants (the user send his agent with a task and the agent is send to contact another participants).

As to claims 88,89 and 104, Tryllian discloses that the capsule (agent) further includes:

h) Logic, to access functionally in a remote mobile commerce system for order processing, payment processing, or messaging utilizing a client-server topology for data transmission (when the user send the agent with a task, like for example, looking for a DVD, the agent goes to a remote commerce system, i.e., marketplace, and came back with information of what the user was looking plus information of the other user i.e., DVD).

As to claim 90, Tryllian discloses that the capsule automatically activates once a certain event occurs (any update to the user by the agent).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. **Claims 84,85,88-90 and 102-104 are rejected** under 35 U.S.C. 102(b) as being anticipated by EP 360,613 to Sarbin et al (Sarbin).

Regarding claims 84 and 102, Sarbin discloses a self-contained business transaction capsule (the information inside card 20), stored on a computer readable medium to conduct a wireless transaction, comprising:

- a) Data regarding transaction products and transaction services (all the data regarding the different machines and their services, i.e., type of gambling games, prizes, etc.).
- b) Data regarding transaction participants (data about the user, the casino and the machines or games available).
- c) Logic, in the form of executable code, enabling interaction between the transaction participants (the user and the casino database or the machine) and the self-contained business transaction capsule (the information inside card 20).
- d) Logic, in the form of executable code, enabling modification of the transaction (every time the card is update by using it, i.e., when the money is used, winnings or losing of it, etc).
- e) Logic, in the form of executable code, regarding the wireless transaction (between the user and the casino or machine) and enabling transfer of the self-contained business transaction capsule (the information inside card 20) from a wireless electronic device (the card itself) to other transaction participants (the casino database or the machine).

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As to claims 85 and 103, Sarbin discloses that the capsule (the information inside 20) includes:

f) Logic, in the form of executable code, enabling copying of the self-contained business transaction capsule to other transaction participants (every time the information inside card 20 is updated, the other participant, i.e., the casino database, copies the information).

As to claims 88,89 and 104, Sarbin discloses that the capsule further includes:

g) Logic in the form of executable code, to access functionality in remote commerce systems for order processing, payment processing, or messaging utilizing a client-server topology for transmission of the self-contained business transaction module from the portable electronic device to one of the remote mobile commerce systems (the casino database or the machine).

As to claim 90, Sarbin discloses that the capsule automatically activates once a certain event occurs (any update of the user gambling).

10. **Claims 84,86-89,102 and 104 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 4,277,837 to Stuckert.

Regarding claims 84 and 102, Stuckert discloses a self-contained business transaction capsule (DSTC information), stored on a computer readable medium to conduct a wireless transaction, comprising:

a) Data regarding transaction products and transaction services (all the data regarding the transaction to be made, services, etc.).

b) Data regarding transaction participants (user pin numbers, etc.).

c) Logic, in the form of executable code, enabling interaction between the transaction participants (the user with the DSTC and the bank, retail store or other business) and the self-contained business transaction capsule (DSTC information).

d) Logic, in the form of executable code, enabling modification of the transaction (pay or receive cash, etc.)

e) Logic, in the form of executable code, regarding the wireless transaction (between the users, Figure 6) and enabling transfer of the self-contained business transaction capsule (the information in the DSTC) from a wireless electronic device (XATR) to other transaction participants (with a different DSTC, Figure 6).

As to claims 86 and 87, Stuckert discloses that the self-contained business transaction capsule further includes logic, in the form of executable code, to access functionality with other wireless devices utilizing a peer-to-peer topology for data transmission (Figure 6).

As to claims 88,89 and 104, Stuckert discloses that the capsule further includes logic in the form of executable code, to access functionality in remote commerce systems for order processing, payment processing, or messaging utilizing a client-server topology for transmission of the self-contained business transaction module from the portable electronic device to one of the remote mobile commerce systems.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 85 and 103 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,277,837 to Stuckert as applied to claims 84 and 102 above, and further in view of EP 360,613 to Sarbin et al (Sarbin).

Stuckert fails to disclose that the capsule (the DSTC information) includes logic, in the form of executable code, enabling copying of the self-contained business transaction capsule to other transaction participants.

Sarbin teaches that it is well known in the art to have logic, in the form of executable code, to enable copying of the self-contained business transaction capsule to other transaction participants (every time the information inside card 20 is updated, the other participant, i.e., the casino database, copies the information).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the logic of copying the capsule to other participants, as taught by Sarbin, into a system as described by Stuckert, in order to update the information of the user with respect to another of the transaction participants (in Stuckert case, a bank or a retail store that the DSTC is used for).

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13. **Claims 86 and 87 are rejected** under 35 U.S.C. 103(a) as being unpatentable over EP 360,613 to Sarbin et al (Sarbin) as applied to claim 84 above, and further in view of US Pat No 4,277,837 to Stuckert.

Sarbin fails to disclose a peer-to-peer topology for the data transmission of information in the card.

Stuckert teaches that it is well known in the art to have a peer-to-peer data transmission (Figure 6) in order to transfer data from one card to another one.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a peer-to-peer transmission, as taught by Stuckert, into a system as described by Sarbin, in order to transfer data or make a transaction from one card to another one.

14. **Claims 91 and 92 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Tryllian as applied to claims 84 and 90 above, and further in view of Bluetooth.

Tryllian fails to disclose the use of short-range radio waves. Tryllian discloses that any wireless portable electronic device can be used (cellular, palm, etc).

Bluetooth teaches that is known in the art to have a portable electronic device of short-range.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by Bluetooth, into a portable electronic system as described by Tryllian, in order to have a better communication.

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Response to Arguments

15. Applicant's arguments, see remarks, page 6, filed on December 13, 2004, with respect to the rejection(s) of claim(s) 84-92 and 102-104 under 102(b) over Amazon, Ogasawara and Mankoff have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tryllian, Sarbin and Stuckert.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo
AU 3676

February 1, 2005.



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